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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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01/10/2000

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FOUR

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EXAMINER

FOUR

ART UNIT

PAPER NUMBER

DATE MAILED:

01/10/2000

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**09/226,046**

Applicant(s)  
**Reppert et al.**

Examiner  
**Michael Pak**

Group Art Unit  
**1646**



☒ Responsive to communication(s) filed on Dec 5, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 33-35 and 37-77 is/are pending in the application.

Of the above, claim(s) 34, 37-52, 54, 56, 58, and 60-77 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 33, 35, 53, 55, 57, and 59 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

**DETAILED ACTION**

1. Applicant's election without traverse of Group I, species D, in Paper No. 11 is acknowledged. Claims 33, 35, 53, 55, 57, and 59 read on this species. Applicants note that examiner may have inadvertently included claim 77 with Group I, but should have been in Group II. Examiner agrees and appreciates the correction.

2. This application contains claims 34, 37-52, 54, 56, 58, and 60-77 drawn to an invention non-elected with traverse in Paper No. 15. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) MPEP § 821.01.

***Claim Rejections - 35 USC § 112, first paragraph***

3. Claims 33, 35, 53, 55, 57, and 59 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a written description rejection.

Claims encompass a genus of melatonin receptor, fragment or analog without specific structure. However, the essential

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feature of the invention is the specific human melatonin receptor consisting of SEQ ID NO: 12. *University of California v. Eli Lilly and Co.* (CAFC) 43 USPQ2d 1398 held that a generic claim to human or mammalian when only the rat protein sequence was disclosed did not have written description in the specification. Thus, the only disclosure of a specific human melatonin receptor does not have written description for the genus of human melatonin receptor whose sequences cannot be envisioned.

***Claim Rejections - 35 USC § 112, second paragraph***

4. Claims 33, 35, 53, 55, 57, and 59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 33, 35, 53, 55, 57, and 59 encompass fragments and analogs the metes and bounds are not clear because no structural limitations are provided.

Claims 57 and 59 encompass the term "hybridizes under the condition of high stringency", the metes and bounds are not clear because it is a relative term.

***Priority***

5. Applicant's claim for domestic priority under 35 U.S.C. 120 is acknowledged. However, the provisional application upon which

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priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 33, 35, 53-60 of this application.

- Application 08/261,357 does not disclose the human melatonin receptor of SEQ ID NO:12.

### *Claim Rejections - 35 USC § 102*

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 33 is rejected under 35 U.S.C. 102(b) as being anticipated by Ying et al. (EM).

Ying et al. teach human melatonin receptor assay (page 93, second column and figure 8).

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Erisawa et al. is a cumulative reference with Ying et al.

9. No claims are allowed.

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10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS**

**ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pak, whose telephone number is (703) 305-7038. The examiner can normally be reached on Monday through Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6561.

Official papers filed by fax should be directed to (703) 303-4242. Faxed draft or informal communications with the examiner should be directed to (703) 303-0234.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 303-0196.

*Michael D. Pak*

Michael Pak  
Primary Patent Examiner  
Art Unit 1646  
22 February 2001